

Response to Office Action
USSN 09/293,509 filed April 15, 1999
Examiner C. White; Art Unit 3713

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allotment given to a player by the secondary game for each kind of symbol image, the first value being converted to a new value in response to a selectable one of multiplication and augmentation of the first value by a predetermined number after the reset operation.

14. The gaming machine of claim 1, wherein the principal game includes a selectable one of a slot game and a poker game.

REMARKS

Amendments are presented herein to improve the form of the subject application and in response to the Examiner's comments in the above-identified Office Action.

Examiner's Response to Applicant's Remarks

The Examiner states that Applicant argues that the Marnell II or Farrell references do not teach or suggest "any interrelationship between the principal and secondary games wherein the principal game can be won by reference to the secondary game" (emphasis added by the Examiner). Further the Applicant argues that there is no teaching in the applied references that the result of the matrix game can be applied to anticipate a win in the principal game. The Examiner directs Applicant's attention to the above claim rejection for an explanation of this claim feature.

Also Applicant, on page 8 of the arguments, recites a passage from page 26, lines 6-15 of the specification that reads as follows:

As described above, the secondary game played on the secondary display screen is separate from the variable display that displays the principal game, but is related to the result of the principal

Response to Office Action
USSN 09/293,509 filed April 15, 1999
Examiner C. White; Art Unit 3713

game, thereby enhancing the player's interest in continuing to play the entire game. The secondary game by the secondary display screen proceeds while indicating histories of the (winning) states displayed in the past by the variable display. Therefore, the player can know whether the completion of the secondary game is near or not. Also, it is easy for the player to know at glance what kind of (winning) pattern has to be displayed in the principal game for completion of the secondary game so that the player may play the game with high interest and expectation. The player can endeavor to win the principal game by paying attention to the progress of the secondary game, thereby greatly elevating the player's interest in the game. (Emphasis Added)

According to the Examiner, this passage was recited by Applicant to show support in the specification for Applicant's assertion that the plying of the secondary game will provide indication to the likelihood of winning the principal game. Applicant, according to the Examiner, states above that "it is easy for the player to know at a glance what kind of (winning) pattern has to be displayed in the principal game for completion of the secondary game ,..." This passage seems to indicate, to the Examiner, that playing of the **primary game** will provide indication of the likelihood of winning the **secondary game**. However, the next sentence, above, states that "[t]he player can endeavor to win the principal game by paying attention to the progress of the secondary game ..." This statement appears to be inconsistent with the previous statement. Nevertheless, the Examiner has considered this area of the disclosure. According to the Examiner, the mere statement that the player can endeavor to win the principal game by paying attention to the progress of the secondary game does not support the argument by the Applicant that "the principal game can be won by reference to the secondary game." This argument seems to indicate that the secondary game affects the winning

probability of the principal game. Applicant's instant disclosure and claims is considered by the Examiner not to support this argument.

Applicant, according to the Examiner, argues that the references of Marnell II and Farrell do not teach the feature of new claim 15. However, the Examiner notes that this application does not include a claim 15. Applicant gratefully acknowledges that this typographical error was brought to its attention by the Examiner. The reference was intended for amended independent claim 1.

The Examiner continues by stating that in addition to the foregoing, Applicant has argued that the references do not teach "a gaming machine wherein a player can earn a profit or receive an award that is increased in response to a secondary game that is played supplemental to a principal game." However, the Examiner states that Applicant has not claimed this feature.

Applicant, as will be discussed below, has addressed by amendments to the claims the Examiner's concerns stated hereinabove, including that the invention includes within its scope a gaming machine wherein a player can earn a profit or receive an award that is increased in response to a secondary game that is played supplemental to a principal game.

Applicant acknowledges that the Examiner has taken notice that Applicant intends to provide a Terminal Disclaimer upon allowance of the claims, and that the provisional double patenting rejection of claims 1-14 remains until such time.

Double Patenting

Claims 1-14 continue to stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 14-16 of copending Application No. 09/268,960 (RM-HPM). The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant claimed invention are drawn to a gaming machine that has a primary game and a secondary game

Response to Office Action
USSN 09/293,509 filed April 15, 1999
Examiner C. White; Art Unit 3713

that achieves the same objective as the claimed invention of copending Application No. 09/268,960. The Examiner concedes that the claim language of the instant application is not exactly the same as that of Application No. 09/268,960. However, the Examiner believes that the invention of the instant application achieves all the same functions as the instant invention of Application No. 09/268,960.

The Examiner has characterized the present rejection as a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant will provide, at such time as allowance of the present case is indicated, an appropriate Terminal Disclaimer that will address and overcome the Examiner's obviousness-type double patenting rejection.

Claim Rejections- 35 U.S.C. § 112, Second Paragraph

Claims 1 and 4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out with particularity and claim distinctly the subject matter that Applicant regards as the invention because, according to the Examiner, there is insufficient antecedent basis for:

the limitation "the plurality of principal game playing states" in lines 10-11 of claim 1; and the phrase "adapted to" in line 3 of claim 4.

According to the Examiner, the referenced language makes the claim unclear.

With respect to the language "the plurality of principal game playing states" in lines 10-11 of claim 1, Applicant has amended the independent claim to specify antecedent basis in the "variable display" clause. Accordingly, this aspect of the Examiner's rejection under 35 U.S.C. § 112, second paragraph, has been overcome.

With respect to the "adapted to" language in line 3 of claim 4, Applicant has amended this claim to delete the referenced language.

In view of the foregoing, the Examiner's rejection under 35 U.S.C. § 112, second paragraph, has been overcome.

Claim Rejections - 35 U.S.C. § 103

Claims 1-2 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Marnell, II (5,393,057) or Farrell (GB 2242300A) references.

CLAIM 1

Regarding claim 1, the Examiner directs Applicant's attention to the detailed explanation in the Final Office Action for a description of the non-amended claim features.

The Examiner states that Applicant amended the claim to include the feature of the display of the image on said secondary display corresponding to a history of each predetermined display state of the principal game and an indication of one of the plurality of principal game playing states that has a likelihood of winning a subsequent principal game. However, it is the Examiner's assertion that, while not explicitly stated in the Marnell II and Farrell references, the gaming machines of the cited references are functionally capable of achieving the instant claim feature of "the display of the image on said secondary display corresponding to a history of each predetermined display state of the principal game and an indication of one of the plurality of principal game playing states that has a likelihood of winning a subsequent principal game."

According to the Examiner, both Farrell and Marnell II teach that the symbols that appear on the win line in the principal game are placed in the secondary matrix. Applicant's attention is directed by the Examiner to the Farrell reference at Fig. 1 and the Marnell II reference at Fig. 1. Therefore, it would be obvious to a person of ordinary skill in the art that the secondary display of

the Farrell reference or the Marnell II reference provides a “history” of the predetermined display state of the principal game. The Examiner continues by stating that the player, by looking at the symbols that are placed in the secondary display, is capable of seeing various patterns of symbols from the reels of the primary game in order to “anticipate” the likelihood of obtaining various combinations of symbols in the subsequent principal game. According to the Examiner, this is a matter of choice well within the functional capabilities of the Farrell or Marnell II references. While this feature is conceded by the Examiner as not being explicitly stated in the Marnell, II and Farrell references, the Examiner further states that the gaming machines of the Farrell or Marnell II references could serve this purpose, if so desired. Therefore, the Examiner asserts that it would have been obvious to modify the invention of the Farrell or Marnell II references to include the determination of the likelihood of winning a subsequent game by viewing the secondary display in order to increase the player’s excitement and gaming activity on the game machine. The Examiner continues the comment by stating that Applicant has not recited any physical structure in the apparatus claim of the instant claimed invention that differs from that of the Farrell or Marnell II references. Applicant, according to the Examiner, merely recites a purpose for the secondary display that is not explicitly recited in the Farrell or Marnell II references. However, according to the Examiner, it is an obvious matter of choice to use the secondary display of the Farrell or Marnell II references for the same purpose as Applicant, if desired.

APPLICANT’S RESPONSE

First, Applicant respectfully disagrees with the Examiner’s assertion that a “player, by looking at the symbols that are placed in the secondary display [*of the Farrell or Marnell II references*], is capable of seeing various patterns of symbols from the reels of the primary game in order to ‘anticipate’ the likelihood of obtaining various combinations of symbols in the subsequent

principal game." More to the point, Applicant respectfully asserts that the Examiner is correct in stating that "this feature is ... not ... explicitly stated in the Marnell, II and Farrell references," and further that it would not be obvious to modify the invention of the Farrell or Marnell II references to include the determination of the likelihood of winning a subsequent game by viewing the secondary display.

The foregoing notwithstanding, and in an effort to expedite prosecution of the present application, Applicant has, without prejudice, amended independent claim 1 to specify subject matter that is not taught or suggested by any combination of the Farrell or Marnell II references. More specifically, amended independent claim 1 now specifies that there is provided:

a secondary display having a display area for displaying a plural number of a single kind of symbol images, the single kind of symbol images being associated with one of the plurality of predetermined display states displayed as a result of the principal game, the number of the single kind of symbol images displayed in the display area being increased each time that the principal game results in the one of the predetermined display states, thereby advancing a secondary game.

None of the references of record, irrespective of whether they are viewed singularly or in combination with each other, teach or suggest the invention specified in claim 1. More specifically, and by way of example, the limitation that the display area is increased each time that the principal game results in the one of the predetermined display states so as to advance the secondary game is not even suggested in any of the reference of record. Further in this regard, it is noted that the Examiner concedes that the use of the secondary display to anticipate the likelihood of obtaining various combinations of symbols in the subsequent principal game is not specifically shown in the references. Applicant respectfully asserts that subject matter that is not shown in the relevant reference(s) cannot be applied to render obvious a claim that contains the subject matter as a specific limitation. Accordingly, claim 1 specifies allowable subject matter over the references of record, and therefore this claim is in allowable condition.

CLAIMS 2-4

Regarding claims 2-4, the Examiner states that the Marnell, II or Farrell references further disclose the secondary display indicating symbol images that correspond to a respectively associated one of the principal game playing states (Marnell II - Abstract; Farrell - Fig. 1, #6, #2; #57).

Claims 2-4 depend from amended independent claim 1 and therefore contain all of the limitations therein. Moreover, these claims have themselves been amended to specify subject matter that is further distinguishable over the references of record.

CLAIMS 5-7

Regarding claims 5-7, the Examiner states that the Marnell, II or Farrell references further disclose providing an award to a player when the secondary display screen satisfies a predetermined condition (Marnell II- col. 7, lines 7-14; Farrell- Fig. 1, #9 and page 9, lines 25-34).

Claims 5-7 depend from amended independent claim 1 and therefore contain all of the limitations therein. Moreover, these claims have themselves been amended to specify subject matter that is further distinguishable over the references of record.

CLAIM 8

Regarding claim 8, the Examiner states that the Marnell, II or Farrell references further disclose the resetting of the secondary display (Marnell II- col. 7, lines 25-34 and col. 6, lines 23-27; Farrell- page 12, lines 20-25).

Claim 8 depends from amended independent claim 1 and therefore contains all of the limitations therein. Moreover, this claim has been amended to specify subject matter that is further distinguishable over the references of record.

CLAIMS 9-12

Regarding claims 9-12, the Examiner states that the Marnell, II or Farrell references disclose all the elements of the claims as discussed above. While Marnell II is considered by the Examiner to teach the clearing of all of the display areas, the Examiner concedes that Marnell II is silent on disclosing the clearing of a single display area. The Farrell reference is considered by the Examiner to disclose the resetting of the display screen or the holding of some of the display areas for another game (p. 12, lines 20-30). The Examiner continues by stating that it would be an obvious design choice to clear either one or all areas according to whether or not the player wanted to maintain some symbol positions in order to increase the player's chances of winning in subsequent games. Therefore, the Examiner concludes that it would have been obvious to include this feature in the systems disclosed in the Marnell II or Farrell references.

Claims 9-12 depend from amended independent claim 1 and therefore contain all of the limitations therein. Moreover, claims 9, 11, and 12 have themselves been amended to specify subject matter that is further distinguishable over the references of record.

CLAIM 13

The Examiner states that regarding claim 13, the Marnell II or Farrell references disclose all of the limitations of the claim as discussed above. The Examiner concedes, however, that the Marnell II or Farrell reference fail to disclose a multiplied payout. The Examiner continues by stating that in an analogous gaming machine, the Wilson Jr., *et al* or Adams references disclose the multiplication of a payout value (Wilson, Jr., *et al.* - Abstract; Adams- Abstract). The Examiner continues by stating that it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in the systems disclosed in the Marnell II or Farrell

references because, according to the Examiner, it is well known in the art to provide multiplied payouts in slot machines to increase the players' interests in the game.

Claim 13 depends from amended independent claim 1 and therefore contains all of the limitations therein. Moreover, this claim has been amended to specify with greater clarity subject matter that is further distinguishable over the references of record. The Wilson Jr., *et al* and Adams references do not add anything to the Marnell II or Farrell references that would render the prior amendment and the arguments presented hereinabove not to be persuasive in support of patentability of amended independent claim.

CLAIM 14

Regarding claim 14, Marnell II is considered by the Examiner to disclose that the primary games are a slot game and a poker game (Fig. 1 and Fig. 2).

Claim 14 depends from amended independent claim 1 and therefore contains all of the limitations therein.

Additional Prior Art - Cited But Not Applied

As previously stated during prosecution of the present case, the Wilson Jr., *et al* and Adams references do not add anything to the Marnell II or Farrell references that would render the prior amendment and the arguments presented hereinabove not to be persuasive in support of patentability of amended independent claim.

Conclusion

It is respectfully asserted that, in view of the foregoing amendments and arguments, the Examiner's rejection of claims 1-14 under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103(a) have been overcome, and that all claims are in allowable condition.

**Response to Office Action
USSN 09/293,509 filed April 15, 1999
Examiner C. White; Art Unit 3713**

In view of the foregoing, it is respectfully requested that the Examiner reconsider the present application, allow the claims, and pass the application for issue. If the Examiner believes that the prosecution of this case can be expedited by a telephone interview, the Examiner is requested to call attorney for Applicant at the telephone number indicated hereinbelow.

Respectfully submitted,



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Annexure 1 - Claim(s) Rewritten to Show Amendments

1. (Thrice Amended) A gaming machine for use by a player, the gaming machine comprising:

a variable display for displaying graphical information corresponding to at least one of a plurality of graphical elements necessary for a principal game, the principal game having associated therewith a plurality of predetermined display states;

a controller coupled to said variable display for causing said variable display to display the graphical information; and

a secondary display having a display area for displaying a plural number of identical images, wherein the identical image is] a single kind of symbol images, the single kind of symbol images being associated with one of [a] the plurality of predetermined display states displayed as a result of the principal game, the [display of the image on said secondary display corresponding to a history of each predetermined display state of the principal game and an indication of a one of the plurality of principal game playing states that has a likelihood of winning a subsequent principal game] number of the single kind of symbol images displayed in the display area being increased each time that the principal game results in the one of the predetermined display states, thereby advancing a secondary game.

2. (Amended) The gaming machine of claim 1, wherein [said] the secondary game is completed when said display area is filled with [display has a secondary display screen for indicating] the plural [individual] number of the single kind of symbol images [, each such symbol image corresponding to a respectively associated one of the predetermined principal game playing states, each symbol image being displayed on the secondary display screen when the principal game results in its respectively associated principal game playing state].

3. (Amended) The gaming machine of claim [2] 1, wherein [the number of symbol images that are displayed on] said secondary display [screen is responsive to the resulting predetermined principal game playing state] has a further display area for displaying a plurality of a further single kind of symbol images.

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4. (Amended) The gaming machine of claim 3, wherein said secondary game [display screen] is completed when a one of said [provided with a plurality of] display and further display areas [each for displaying a respective plurality of a particular respectively associated one of the symbol images, each of said display areas being adapted to display the plurality of the respectively associated one of the symbol images successively alongside each other] is filled with its respective single kind of symbol images.

5. (Amended) The gaming machine of claim 4, wherein an award is given to a player when [the information displayed on said secondary display satisfies a predetermined condition] said secondary game is completed.

6. (Amended) The gaming machine of claim [5] 3, wherein [the predetermined condition is satisfied when one of said display areas is filled with the respectively associated one of the symbol images] said display and further display areas are allotted respective values.

7. (Amended) The gaming machine of claim 6, wherein the [amount of the] award given to the player is responsive to the particular symbol images displayed as filling the respectively associated one of said display and further display [area] areas.

8. (Amended) The gaming machine of claim 5, wherein [the] said controller executes a reset operation of said secondary display [screen] when said [secondary display screen indicates that the predetermined condition has been satisfied] secondary game is completed.

9. The gaming machine of claim 6, wherein [the] said controller executes a reset operation of said secondary display [screen], after any one of [the] said display areas has been filled with symbol images.

10. The gaming machine of claim 9, wherein a display area that is filled with symbol images is cleared to a blank condition in response to the execution of the reset operation.

11. (Amended) The gaming machine of claim 9, wherein [all of the] said display and further display areas are cleared to [the] a blank condition in response to the execution of the reset operation.

12. (Amended) The gaming machine of claim 9, wherein [the] said controller is arranged to [select] perform a selection between a first reset operation for clearing to a blank condition only a one of said display and further display [area] areas filled with symbol images [or] and a second reset operation for clearing to a blank condition all of [the] said display areas.

Response to Office Action

USSN 09/293,509 filed April 15, 1999

Examiner C. White; Art Unit 3713



13. (Amended) The gaming machine of claim 9, wherein said secondary display is further provided with an allotment display portion [to indicate] for indicating a first value representing an allotment given to a player by the secondary game for each kind of symbol image, the first value being converted to a new value in response to a selectable one of multiplication and augmentation of the first value by a predetermined number after the reset operation.

14. The gaming machine of claim 1, wherein the principal game includes a selectable one of a slot game and a poker game.

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